Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte RICHARD C. MARLOR and PAUL W. SALVI

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Appeal No. 1998-0094
Application No. 08/393,617

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Before MARTIN, BARRETT, and BARRY, Administrative Patent Judges.

MARTIN, Administrative Patent Judge.

DECISION ON REQUEST FOR REHEARING

Appellants have requested rehearing of our January 24, 2000, Decision on Appeal ("Decision") affirming the examiner's rejection of claims 1-4 for obviousness over Snell et al. (Snell) in view of Weaver.

As noted in our Decision (at 6-7), the examiner explained the motivation for replacing PbO in Snell et al.'s (Snell's) solder glass with ZnO as follows:

> Weaver shows that ZnO is equivalent to PbO for use in solder glass. See in particular the abstract, lines 7

> and 8, column 2 lines 31 and 32, column 2 lines 57 and 58, and column 3 lines 9 and 10 in Weaver. Therefore, because these two components were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute ZnO for PbO in the solder glass 22 of Snell et al '944. For example, one reason for substituting ZnO for PbO might be the known safety hazards associated with lead use. [Emphasis added.]

(Final Rej. at 3-4; Answer at 4-5). However, the "safety hazard" motivation posed by the examiner was not addressed in the Brief. Instead, the Brief, whose argument portion reads in its entirety as follows, challenges the rejection on the sole ground that the references fail to suggest appellants' disclosed motivation for replacing Snell's lead oxide with zinc oxide, i.e., to increase the melting temperature:

> ARGUMENTS
>
> The rejection of Claims 1-4 under 35 U.S.C. § 103 as being unpatentable over Snell '944 in view of Weaver '943 is believed to be in error and reversal is requested.
>
> Snell '944 is discussed in the instant specification and includes a specific formulation based on an antimony oxide-boron oxide system which further contains 5% PbO and has a melting point, i.e., becomes molten, at about 350°C.
>
> The instant claims all relate to an antimony oxide-boron oxide system containing specific amounts of zinc oxide to control the melting temperature of the solder glass.
>
> Weaver, on the other hand, relates to a phosphorous oxide-vanadium oxide system which may or may not

> include zinc oxide or lead oxide. See, Weaver, Col. 3, line 6, wherein it is possible for his glass to have neither lead nor zinc. It is respectfully suggested that the fact zinc or lead oxides, when included, may be equally compatible in the phosphorous oxide-vanadium oxide system is no suggestion to one skilled in the art that zinc oxide can be employed as a substitute for lead oxide in an antimony oxide-boron [oxide] system, particularly when used in specific amounts to control the molten range of solder glasses for use with electrical devices.
>
> The most that can be said for the Examiner's suggested combination is that it might have been obvious to try; however, obvious to try is not the standard of § 103. Furthermore, the suggestion that it would have been obvious to one skilled in the art to look to Weaver if one wanted to replace the lead oxide of Snell would appear to be meaningless when one studies the instant specification and sees that the objects of the present invention are to provide a solder glass for use with electrical devices having seal temperatures in the neighborhood of 400°C, which glasses do not deleteriously effect [sic] molybdenum. [Emphasis added.]

After we noted that a proper motivation for combining reference teachings under § 103 is not limited to the specific motivation disclosed in appellants' specification, In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992) (Decision at 7-8), we affirmed the rejection because appellants failed to address the examiner's proposed motivation (id. at 8).

Appellants' request for rehearing (at 2) challenges our decision on the ground that

> [a]n Applicant's burden to rebut an allegation of prima facie obviousness does not arise until the

> Examiner has established that a prima facie case of obviousness exists. In re Rinehart, 189 USPQ 143 (CCPA 1976); MPEP §2142. The Board acknowledges in its decision that the Appellants challenged the evidence relied upon by the examiner as failing to establish a prima facie case of obviousness. Decision at 4. Thus, the Board should have considered all of the factors in the legal test for prima facie obviousness before examining the Appellants' arguments in rebuttal.

Appellants are confusing an argument attacking the sufficiency of the evidence relied on by an examiner to establish a prima facie case of obviousness, which is the type of argument appellants made in the Brief, with a rebuttal argument, which is an argument based on evidence tending to show nonobviousness. See In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998):

> To reject claims in an application under section 103, an examiner must show an unrebutted prima facie case of obviousness. See In re Deuel, 51 F.3d 1552, 1557, 34 USPQ2d 1210, 1214 (Fed. Cir. 1995). In the absence of a proper prima facie case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of prima facie obviousness or by rebutting the prima facie case with evidence of secondary indicia of nonobviousness. See id.

See also Tec Air Inc. v. Denso Mfg. Michigan Inc., 192 F.3d 1353, 1358, 52 USPQ2d 1292, 1298 (Fed. Cir. 1999):

> [E]ven assuming that Denso established a prima facie case of obviousness, Tec Air presented sufficient objective evidence of nonobviousness to rebut it. "[O]bjective evidence of non-obviousness may be used to rebut a prima facie case of obviousness based on prior art references." WMS Gaming Inc. v. International Game Tech., 184 F.3d 1339, 1359, 51 USPQ2d 1385, 1400 (Fed. Cir. 1999). This type of evidence "may include commercial success [and] long-felt but unsolved need." Id. "Whether the evidence presented suffices to rebut the prima facie case is part of the ultimate conclusion of obviousness and is therefore a question of law." In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). [Brackets in original.]

Furthermore, an appellant who is challenging the sufficiency of an examiner's prima facie case for obviousness has the burden of identifying the errors in the examiner's position: "While this court reviews the Board's determination in light of the entire record, an applicant may specifically challenge an obviousness rejection by showing that the Board reached an incorrect conclusion of obviousness or that the Board based its obviousness determination on incorrect factual predicates." Rouffet, 149 F.3d at 1355, 47 USPQ2d at 1455. See also Gechter v. Davidson, 116 F.3d 1454, 1460 & n.3, 43 USPQ2d 1030, 1035 & n.3 (Fed. Cir. 1997), which requires that the Board address the factual findings

and legal conclusions of the examiner which are contested by the appellant:

> [W]e expect that the Board's anticipation analysis be conducted on a limitation by limitation basis, with specific fact findings for each contested limitation and satisfactory explanations for such findings.[3]
>
> _____
>
> [3] While not directly presented here, obviousness determinations, when appropriate, similarly must rest on fact findings, adequately explained, for each of the relevant obviousness factors in the Supreme Court's decision in Graham [v. John Deere Co.], 383 U.S. [1,] 17-18, 148 USPQ [459,] 467 [(1966)], and its progeny in this court, see, e.g., Loctite [Corp. v. Ultraseal Ltd.], 781 F.2d [861,] 872, 228 USPQ [90,] 97 [(Fed. Cir. 1985)].

Hence, as regards the sufficiency of the examiner's prima facie case for obviousness, we were required to consider only the arguments made in the Brief. Consequently, we were not required to sua sponte consider the attacks on the prima facie case for obviousness which appellants are raising for the first time in the request for rehearing (at 2-4), including that one skilled in the art would not have had a reasonable expectation of success in combining the reference teachings in the manner proposed by the examiner, as required by In re Vaeck, 947 F.2d 488, 493, 20 USPQ 1438, 1442 (Fed. Cir. 1991). More particularly, we were not required to determine whether a reasonable expectation of success is negated by (a) Weaver's disclosure that 15% is the upper limit

on the total amount of oxides of boron and antimony (col. 3, ll. 31-34) or (b) Weaver's statement that the composition of these components is "not at all critical as long as they, in combination with their percentage content, do not materially or significantly adversely affect the desired properties of the resulting glass" (col. 3, ll. 24-28).

For the forgoing reasons, we likewise were not required to sua sponte discount the examiner's proposed "safety hazard" motivation on the ground, argued for the first time in the request for rehearing (at 4), that "none of the cited references discusses the health hazards of lead oxide nor [sic] how such a concern would motivate one skilled in the art."

In summary, because appellants' opening brief did not challenge the examiner's prima facie case for obviousness on the various grounds now argued in the request for rehearing, we were not required to address those grounds in the Decision. Nor are we required to address the merits of these newly argued grounds in this decision on appellants' request for rehearing, as we cannot have misapprehended or overlooked arguments not made in the Brief. See 37 CFR § 1.197(b) (a request for rehearing must "state with particularity the points believed to have been

misapprehended or overlooked in rendering the decision and also state all other grounds upon which rehearing is sought.").

DENIED

JOHN C. MARTIN Administrative Patent Judge	)
LEE E. BARRETT Administrative Patent Judge	) BOARD OF PATENT) APPEALS AND) INTERFERENCES
LANCE LEONARD BARRY Administrative Patent Judge	)

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